



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,075	09/22/2004	Raoul Donath	001227/0152	1247
69095 7590 07/31/2008 STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER WOODALL, NICHOLAS W				
ART UNIT 3733		PAPER NUMBER		
MAIL DATE 07/31/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/509,075

**Applicant(s)**

DONATH, RAOUL

**Examiner**

Nicholas Woodall

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 9, 10 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 9, 10 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to applicant's amendment received on 04/14/2008.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 9, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bono (U.S. Patent 6,755,829) in view of Schaffler-Wachter (U.S. Publication 2001/0012937) and Katz (U.S. Patent 5,989,254).

Bono discloses a device comprising a connection element and a sealing cap. The connection element includes a central axis, an external surface, an upper end, a lower end, a first cavity extending coaxially along the central axis from the upper end to the lower end and including a shoulder having a level bearing surface of a circular-ring shape at the lower end, and a first channel passing through the connection element transversely to the central axis for receiving the longitudinal carrier. The sealing cap includes a front end, a rear end, and a second cavity opening at the front end. Bono further discloses the internal surface of the connecting element and the external surface of the sealing cap include complementary arresting means extending continuously, concentrically, and non-threadingly around the central axis, wherein the concentric continuity of the arresting means is interrupted by the first and second channels in order to secure the sealing cap to the connection element. Bono fails to disclose a device

Art Unit: 3733

wherein the complementary arresting means includes non-threaded projections and recess providing a plurality of latch positions parallel to the central axis, wherein each latch position axially displaces the sealing cap of the connection element and the device further comprising a securing element. Katz teaches a device comprising a securing means that includes a pin and hole configuration in order to restrain the connection element to the pedicle screw (column 2 lines 61-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono further comprising a securing means in view of Katz in order to restrain the connection element to the pedicle screw. As discussed above, Bono discloses a device comprising complementary arresting means comprising non-threaded projections and recesses in order to secure the connection element to the sealing cap. Schaffler-Wachter teaches a device comprising a connecting element and sealing cap including a set screw coupled to the second end of the sealing cap and two slots orthogonal to the second channel extending from the front end of the sealing cap, wherein the external surface of the connection element and the internal surface of the sealing cap includes complementary arresting means comprising non-threaded projections and recesses providing an axial latch position parallel to the central axis, wherein the complementary arresting means includes a saw-tooth depression on the internal surface of the sealing cap and saw-tooth projection in order to secure the connection element to the sealing cap. Because both Bono and Schaffler-Wachter teach a device comprising complementary arresting means, it would have been obvious to one having ordinary skill in the art at the time invention was made to substitute one complementary arresting

means for the other in order to achieve the predictable results of securing the connection element to the securing cap.

The device of Bono as modified by Schaffler-Wachter as further modified by Katz discloses the invention as claimed except for the projection being on the internal surface of the sealing cap and the depression being on the external surface of the connection element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter as further modified by Katz wherein the projection is on the internal surface of the sealing cap and the depression on the external surface, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In *re Einstein*, 8 USPQ 167.

The device of Bono as modified by Schaffler-Wachter as further modified by Katz discloses the invention as claimed except for the complementary arresting means further comprising a plurality of bulges and depressions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter as further modified by Katz, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

4. Claims 1, 2, 4, 5, 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bono (U.S. Patent 6,755,829) in view of Schaffler-Wachter (U.S. Publication 2001/0012937) and Nichols (U.S. Patent 6,090,111).

Bono discloses a device comprising a connection element and a sealing cap. The connection element includes a central axis, an external surface, an upper end, a lower end, a first cavity extending coaxially along the central axis from the upper end to the lower end and including a shoulder having a level bearing surface of a circular-ring shape at the lower end, and a first channel passing through the connection element transversely to the central axis for receiving the longitudinal carrier. The sealing cap includes a front end, a rear end, and a second cavity opening at the front end. Bone further discloses the internal surface of the connecting element and the external surface of the sealing cap include complementary arresting means extending continuously, concentrically, and non-threadingly around the central axis, wherein the concentric continuity of the arresting means is interrupted by the first and second channels in order to secure the sealing cap to the connection element. Bono fails to disclose a device wherein the complementary arresting means includes non-threaded projections and recess providing a plurality of latch positions parallel to the central axis, wherein each latch position axially displaces the sealing cap of the connection element and the device further comprising a securing element. Nichols teaches a device comprising a securing means that includes a snap ring and groove configuration in order to retain the pedicle screw (column 4 lines 5-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono further comprising a securing means in view of Nichols in order to restrain the connection element to the pedicle screw. As discussed above, Bono discloses a device comprising complementary arresting means comprising non-threaded projections and recesses in

order to secure the connection element to the sealing cap. Schaffler-Wachter teaches a device comprising a connecting element and sealing cap including a set screw coupled to the second end of the sealing cap and two slots orthogonal to the second channel extending from the front end of the sealing cap, wherein the external surface of the connection element and the internal surface of the sealing cap includes complementary arresting means comprising non-threaded projections and recesses providing an axial latch position parallel to the central axis, wherein the complementary arresting means includes a saw-tooth depression on the internal surface of the sealing cap and saw-tooth projection in order to secure the connection element to the sealing cap. Because both Bono and Schaffler-Wachter teach a device comprising complementary arresting means, it would have been obvious to one having ordinary skill in the art at the time invention was made to substitute one complementary arresting means for the other in order to achieve the predictable results of securing the connection element to the securing cap.

The device of Bono as modified by Schaffler-Wachter as further modified by Nichols discloses the invention as claimed except for the projection being on the internal surface of the sealing cap and the depression being on the external surface of the connection element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter as further modified by Nichols wherein the projection is on the internal surface of the sealing cap and the depression on the external surface, since it has been held

that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

The device of Bono as modified by Schaffler-Wachter as further modified by Nichols discloses the invention as claimed except for the complementary arresting means further comprising a plurality of bulges and depressions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter as further modified by Nichols, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

5. Claims 15, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bono (U.S. Patent 6,755,829) in view of Schaffler-Wachter (U.S. Publication 2001/0012937).

Bono discloses a device comprising a connection element and a sealing cap. The connection element includes a central axis, an external surface, an upper end, a lower end, a first cavity extending coaxially along the central axis from the upper end to the lower end and including a shoulder having a level bearing surface of a circular-ring shape at the lower end, and a first channel passing through the connection element transversely to the central axis for receiving the longitudinal carrier. The sealing cap includes a front end, a rear end, and a second cavity opening at the front end. Bone further discloses the internal surface of the connecting element and the external surface of the sealing cap include complementary arresting means extending continuously,



concentrically, and non-threadingly around the central axis, wherein the concentric continuity of the arresting means is interrupted by the first and second channels in order to secure the sealing cap to the connection element. Bono fails to disclose a device wherein the complementary arresting means includes non-threaded projections and recess providing a plurality of latch positions parallel to the central axis, wherein each latch position axially displaces the sealing cap of the connection element. As discussed above, Bono discloses a device comprising complementary arresting means comprising non-threaded projections and recesses in order to secure the connection element to the sealing cap. Schaffler-Wachter teaches a device comprising a connecting element and sealing cap including a set screw coupled to the second end of the sealing cap and two slots orthogonal to the second channel extending from the front end of the sealing cap, wherein the external surface of the connection element and the internal surface of the sealing cap includes complementary arresting means comprising non-threaded projections and recesses providing an axial latch position parallel to the central axis, wherein the complementary arresting means includes a saw-tooth depression on the internal surface of the sealing cap and saw-tooth projection in order to secure the connection element to the sealing cap. Because both Bono and Schaffler-Wachter teach a device comprising complementary arresting means, it would have been obvious to one having ordinary skill in the art at the time invention was made to substitute one complementary arresting means for the other in order to achieve the predictable results of securing the connection element to the securing cap.

The device of Bono as modified by Schaffler-Wachter discloses the invention as claimed except for the projection being on the internal surface of the sealing cap and the depression being on the external surface of the connection element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter as further modified by Nichols wherein the projection is on the internal surface of the sealing cap and the depression on the external surface, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

The device of Bono as modified by Schaffler-Wachter discloses the invention as claimed except for the complementary arresting means further comprising a plurality of bulges and depressions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter as further modified by Nichols, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bono (U.S. Patent 6,755,829) in view of Schaffler-Wachter (U.S. Publication 2001/0012937) further in view of Katz (U.S. Patent 5,989,254).

The device of Bono as modified by Schaffler-Wachter discloses the invention as claimed except for the device further comprising a securing element. Katz teaches a device comprising a securing means that includes a pin and hole configuration in order

to restrain the connection element to the pedicle screw (column 2 lines 61-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Bono as modified by Schaffler-Wachter further comprising a securing means in view of Katz in order to restrain the connection element to the pedicle screw.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 2, 4, 5, 9, 10, and 15-21 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds of rejection as necessitated by the amendments making this office action **FINAL**.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3733

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733